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Application No: 09/938,148  
Attorney's Docket No: US10410**REMARKS**

In section 4, on page 3, the Office Action rejects claims 1, 2, 13, 14, 16, 19 and 20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,424,370 to Courtney in view of U.S. Patent No. 5,831,669 to Adrain. This rejection is respectfully traversed.

In the final sentence of the rejection on page 3, the Office Action alleges the motivation to combine certain portions of the disclosure in Courtney and Adrain to the exclusion of certain other portions of the disclosure in Courtney and Adrain.

It is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. Rather, prior art references may be modified or combined to render obvious a subsequent invention only if there was some suggestion or motivation to do so derived from the prior art itself, the nature of the problem to be solved, or the knowledge of one of ordinary skill in the art. *Sibia Neurosciences*, 225 F.3d 1349, 1356 (Fed. Cir. 2000); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

"The factual inquiry whether to combine references must be thorough and searching." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). Here, it does not appear that the Examiner has conducted the requisite "thorough and searching" factual inquiry. Rather, the Examiner has made no indication whatsoever of where a teaching or suggestion appears in the prior art references that they be combined in the manner necessary to result in the subject matter according to the combinations recited in the rejected claims. The

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"factual question of motivation [to combine references] is material to patentability, and [can] not be resolved on subjective belief and unknown authority." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Here, it appears that the Examiner improperly relies on the Examiner's own "subjective belief and unknown authority" to establish the motivation to combine references essential to an obviousness inquiry by making an unsupported allegation regarding what would be within the knowledge of one having an ordinary level of skill in the art at the time the application was filed. In other words, the Examiner attempts to substitute facts within the personal knowledge of the Examiner for a reference showing the asserted motivation to combine the references. Applicant respectfully submits that this is improper for at least the following reasons.

According to 37 C.F.R. § 1.104(d)(2), discussed and cited in M.P.E.P. § 2144.03, the Examiner is required to submit an affidavit supporting the facts of which the Examiner relies upon within the Examiner's own knowledge, subject to contradiction or explanation by the Applicant and other persons. Applicant requests such an affidavit. If the Examiner is relying on personal knowledge regarding what would have been known by a person having an ordinary level of skill in the art at the time the application was filed outside of what is disclosed, taught and suggested by the applied references, then Applicant requests that the affidavit specify the facts upon which that personal knowledge is based.

Applicant respectfully asserts that only by the impermissible use of hindsight knowledge of Applicant's own disclosure would the Examiner have acquired a motivation to combine the teachings of the cited references according the precise combination including certain elements

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and excluding certain others as necessary to achieve the subject matter according to the combinations recited in the rejected claims. Applicant further asserts that the Examiner's unsupported allegation of what would be known by a person having an ordinary level of skill in the art at the time the application was filed is a false substitute for this impermissible use of hindsight knowledge of Applicant's own disclosure.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1, 2, 13, 14, 16, 19 and 20 as allegedly being unpatentable over Courtney in view of Adrain be withdrawn.

In section 5 on page 4, the Office Action rejects claims 3, 14 and 17 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Courtney in view of Adrain and further in view U.S. Patent No. 6,744,462 to Gutta et al. (hereinafter "Gutta"). This rejection is respectfully traversed.

Claims 3, 14 and 17 are allowable based at least on their dependence from claims 1, 13 and 16, respectively, for at least the reasons stated above in connection with the rejection of claims 1, 13 and 16. Therefore, it is respectfully requested that the rejection of claims 3, 14 and 17 as allegedly being unpatentable over Courtney in view of Adrain and further in view of Gutta be withdrawn.

In section 6, on pages 4-6, the Office Action rejects claims 4-9, 15 and 18 as allegedly being unpatentable over Courtney in view of Adrain, further in view of U.S. Patent No. 5,895,453 to Cook, and still further in view of U.S. Patent No. 6,654,047 to Iizaka . This rejection is respectfully traversed.

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Claims 4-9, 15 and 18 are allowable based at least on their dependence from claims 1, 13 and 16 for the reasons stated above in connection with the rejection of claims 1, 13 and 16. Therefore, it is respectfully requested that the rejection of claims 4-9, 15 and 18 as allegedly being unpatentable over Courtney in view of Adrain, further in view of Cook and further in view of Iizaka be withdrawn.

#### CONCLUSION

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

While we believe that the instant amendment places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner contact the correspondence attorney listed below at the telephone number listed below in order to expeditiously resolve any outstanding issues.

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KRAMER & AMADO, P.C.

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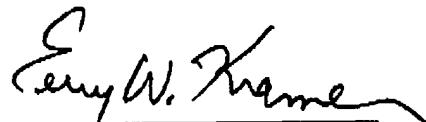
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Respectfully submitted,  
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